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U.S. SERIAL NO. 10/066,248  
PATENT**REMARKS**

Claims 21-40 were originally filed in the present application.

Claims 21-40 are pending in the present application.

Claims 21-40 were rejected in the August 1, 2006 Office Action.

No claims have been allowed.

Claims 21-24, 26-28, 30, 32, 34, 35 and 37 are amended herein.

Claims 21-40 remain in the present application.

Reconsideration of the claims is respectfully requested.

The Office issued a Final Office Action dated March 23, 2006 and an Advisory Action dated June 6, 2006. On June 20, 2006, Applicant filed a Request for Continued Examination (RCE) and a Reply under 37 C.F.R. §1.114. Applicant's June 20, 2006 Reply included substantive changes to the claims. The Office granted Applicant's RCE and issued a final Office Action dated August 1, 2006. Applicant subsequently contacted the Examiner regarding the status of the August 1, 2006 Office Action. The Examiner agreed that because substantive changes to the claims were made in the June 20, 2006 Reply, the status of the August 1, 2006 Office Action may be changed from a "final" to a "non-final" Office Action. Accordingly, Applicant respectfully requests that the status of the August 1, 2006 Office Action be reconsidered and, at the very least, be reissued as a "non-final" Office Action.

Applicant filed a Reply under 37 C.F.R. §1.116 to the August 1, 2006 Office Action by facsimile on September 29, 2006. In a telephone conference call with Bhaveeni Parmar on October

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2, 2006, Examiner Wong suggested that the limitation of "according to supplemental channel configuration information in a handoff required message" be added to independent Claim 21 and similarly to independent Claims 28 and 34. Applicant now files this Supplemental Reply as per the Examiner's suggestion and reincorporates the claim amendments made in the September 29, 2006 Reply. Applicant therefore respectfully requests favorable reconsideration and allowance of the present application.

In Section 1 of the August 1, 2006 Office Action, the Examiner objects to several claims citing informalities, some which were already addressed in Applicant's June 20, 2006 Reply. With respect to Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37, the Examiner cites that the limitation of "capable of" is used. Taking for instance, the Examiner's objection to Claim 21, the Examiner justifies ignoring the claim limitation "capable of" by citing MPEP §2111.04. MPEP § 2111.04 indicates that the determination of whether clauses (such as "adapted to/for," or "wherein/whereby") are a limitation in a claim is not subject to a per se rule, but instead depends on the specific facts of the case. MPEP § 2111.04, p. 2100-46 (8<sup>th</sup> ed., rev. 5, August 2006). When such a clause states a condition that is material to patentability, the clause cannot be ignored in order to change the substance of the invention. *Id.* In contrast, the "capable of" limitation in the pre-amended version of Claim 21 imposes, for example, a capability requirement on the source base station – *i.e.*, the source base station must be able to communicate with a mobile station and a target station. As another example, Claim 21 also imposes a capability requirement on the target base station – *i.e.*, the target base station must be able to communication with said source base station.

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Similar arguments hold true for Claims 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37. Thus, each “capable of” limitation in Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37 imposes a capability requirement on a claim element. Moreover, the Examiner is invited to consider the non-precedential BPAI decision in *Ex parte Prall*, Appeal No. 2003-1556, which may be electronically accessed at: [www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf](http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf). The limitation at issue in *Prall* imposed a capability requirement on the respective claim element – like that in the current application.

Applicant notes that although usage of the “capable of” language was proper, Applicant has elected to amend the claims merely to expedite issuance of the Application. Accordingly, Applicant respectfully requests that the objection to Claims 21, 22, 23, 24, 26, 27, 28, 30, 32, 34, 35 and 37 be withdrawn.

In Section 2 of the August 1, 2006 Office Action, the Examiner rejected Claims 21, 22 and 28 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,167,270 to *Rezaiifar, et al.* (the “Rezaiifar reference”). Applicant respectfully disagrees.

Claim 21 requires an apparatus for handing off a supplemental channel during a high speed packet data call. Claim 21 also requires that said source base station is configured to hand off said supplemental channel to said target base station during said high speed packet data call. The Rezaiifar reference fails to disclose each and every element of Claim 21.

The Rezaiifar reference teaches a system where if a remote station transmits the inter-cell  $\Delta$  power level to bases stations indicating that the forward link power from one base station (e.g., BS

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C) is higher than the power level received from another base station (e.g., BS A), then the forward supplemental channel transmission is switched from BS A to base station BS C. Rezaiifar reference, column 13, lines 12-25 and FIGURES 5A and 5B. Accordingly, there is no teaching or disclosure with the Rezaiifar reference of handing off the supplemental channel during a high speed packet data call, as required by Claim 21 and its dependent, Claim 22. Similarly, the Rezaiifar reference fails to disclose a method comprising the step of providing said source base station configured to hand off said supplemental channel to said target base station, as required by Claim 28. In addition, the Rezaiifar reference fails to teach or disclose supplemental channel configuration information in a handoff required message, as required by Claims 21, 22 and 28.

Claims 21, 22 and 28 are therefore patentably distinguishable over the art cited and are thus allowable. Accordingly, Applicant requests favorable reconsideration and the withdrawal of §102 rejection.

In Section 3 of the August 1, 2006 Office Action, the Examiner rejected Claims 23 and 29 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference as applied to Claim 22 above and in view of U.S. Patent Publication No. 2002/0141370 to *Arbol* (the "Arbol reference"). Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either taken alone or in combination with the Arbol reference, of handing off the supplemental channel during a high speed packet data call or of supplemental channel configuration information in a handoff required message, as required by Claim 21 and its dependent, Claim 23. Similarly, the Rezaiifar reference and the

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Arbol reference fails to disclose a method comprising the step of providing said source base station configured to hand off said supplemental channel to said target base station or of any supplemental channel configuration information in a handoff required message, as required by Claim 28 and its dependent Claim 29. Moreover, there is no motivation or suggestion within the Rezaiifar reference or the Arbol reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 23 and 29.

Accordingly, Claims 23 and 29 are patentably distinguishable over the art cited and are thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

In Section 4 of the August 1, 2006 Office Action, the Examiner rejected Claims 24, 25 and 30-33 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in further view of U.S. Patent Publication No. 2002/0147020 to *Iguchi, et al.* (the "Iguchi reference"). Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either taken alone or in combination with the Iguchi reference, of handing off the supplemental channel during a high speed packet data call or of supplemental channel configuration information in a handoff required message, as required by Claim 21 and its dependents, Claims 24 and 25. Similarly, the Rezaiifar reference and the Iguchi reference fails to disclose a method comprising the step of providing said source base station configured to hand off said supplemental channel to said target base station or of any supplemental channel configuration information in a handoff required message, as required by Claim

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28 and its dependent Claims 30-33. Moreover, there is no motivation or suggestion within the Rezaiifar reference or the Iguchi reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 24, 25 and 30-33.

Accordingly, Claims 24, 25 and 30-33 are patentably distinguishable over the art cited and are thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

In Section 5 of the August 1, 2006 Office Action, the Examiner rejected Claim 26 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Iguchi reference as applied to Claim 24 and in further view of U.S. Patent No. 6,947,398 to *Ahmed, et al.* (the "Ahmed reference"). Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either taken alone or in combination with the Iguchi reference and the Ahmed reference, of handing off the supplemental channel during a high speed packet data call or of supplemental channel configuration information in a handoff required message, as required by Claim 21 and its dependent, Claim 26. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Iguchi reference or the Ahmed reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claim 26.

Accordingly, Claim 26 is patentably distinguishable over the art cited and is thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

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In Section 6 of the August 1, 2006 Office Action, the Examiner rejected Claim 27 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Iguchi reference and the Ahmed reference as applied to Claim 26 and in further view of U.S. Patent No. 5,329,635 to *Wadin, et al.* (the "Wadin reference"). Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either taken alone or in combination with the Iguchi reference, the Ahmed and the Wadin reference, of handing off the supplemental channel during a high speed packet data call or of supplemental channel configuration information in a handoff required message, as required by Claim 21 and its dependent, Claim 27. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Iguchi reference, the Ahmed reference or the Wadin reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claim 27.

Accordingly, Claim 27 is patentably distinguishable over the art cited and is thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

In Section 7 of the August 1, 2006 Office Action, the Examiner rejected Claims 34-38 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Abrol reference, Iguchi reference, Ahmed reference and the Wadin reference. Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either alone or in combination with the Abrol reference, the Iguchi reference, the Ahmed reference and the Wadin reference, of a method comprising the step of providing said source base station configured to hand off said supplemental channel to said target base station or any supplemental channel configuration

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information in a handoff required message, as required by Claim 34 and its dependents Claims 35-38. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Abrol reference, the Iguchi reference, the Ahmed reference or the Wadin reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 34-38.

Accordingly, Claims 34-38 are patentably distinguishable over the art cited and are thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

In Section 8 of the August 1, 2006 Office Action, the Examiner rejected Claims 39 and 40 under 35 U.S.C. § 103(a) as unpatentable over the Rezaiifar reference in view of the Abrol reference, Iguchi reference, Ahmed reference and Wadin reference as applied to Claim 34 and further in view of IS-95 CDMA and cdma2000 textbook by Garg (the "CDMA reference"). Applicant respectfully disagrees.

There is no teaching or disclosure within the Rezaiifar reference, either alone or in combination with the Abrol reference, the Iguchi reference, the Ahmed reference, the Wadin reference and the CDMA reference, of a method comprising the step of providing said source base station configured to hand off said supplemental channel to said target base station or of supplemental channel configuration information in a handoff required message, as required by Claim 34 and its dependents Claims 39-40. Moreover, there is no motivation or suggestion within the Rezaiifar reference, the Abrol reference, the Iguchi reference, the Ahmed reference, the Wadin



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reference and the CDMA reference to prompt one of ordinary skill to selectively and non-inventively combine and then *seek out* still other elements as required by Claims 39 and 40.

Accordingly, Claims 39 and 40 are patentably distinguishable over the art cited and are thus allowable. Applicant therefore requests favorable reconsideration and the withdrawal of the §103 rejection.

In Section 9 of the August 1, 2006 Office Action, the Examiner provides a response to Applicant's Reply dated June 20, 2006. Applicant respectfully traverses the response at this time and maintains that, at most, the Rezaiifar reference discloses handing off the data on supplemental channels, but fails to disclose handing off the supplemental channel itself. In addition, Applicant notes that the Rezaiifar reference fails to disclose any supplemental channel configuration information in a handoff required message.

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PATENTSUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [jmockler@munckbutrus.com](mailto:jmockler@munckbutrus.com).

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

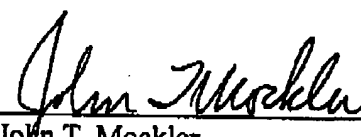
Respectfully submitted,

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